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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,140	09/07/2001	Atsushi Yano	6920/0J8	7924
7278	7590	07/01/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,140

Applicant(s)

YANO ET AL.

Examiner

Tan Dean D. Nguyen

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2, 3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 09/07/01 and 12/18/01 were filed after the mailing date of the application on 09/07/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It's not clear the connection of the phrase "a recovery process" on line 5 to the previous lines.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MADON (US Patent 4,481,383).

As for Independent claim 1, MADON discloses a management system for an information communication network system including recording arrangement for billing a customer for services rendered by the system comprising: (a) means for recording a problem start time of the communication (service interrupted), (b) means for recording a time the service was restored (problem has been resolved) after contact has been made to the customer by a monitor center (operator), and (c) means for computing a problem duration (elapse) time from (a) to (b) (see col. 1, lines 20-30, 43-57, Figs. 30, 31 and 32). Note that MADON teaches that (1) the service charges will be incurred only when facilities are active and (2) the charges will be adjusted to compensate for the time that are used to re-establish the interrupted service (col. 1, lines 55-57). Note that the main processor system (Fig. 11) includes timers (1107) to keep track of the time and interrupt controller (1106). Fig. 30 discloses means for and step of "recording time" (3000) and "computing elapsed time" (3001). Alternatively, the recording of time out of service (or start of problem and end of problem) would have been obvious in view of the teaching above (1) and (2) to accurately charge the customer for the service. Alternatively, the substitution of "operator assistance or operator" on col. 1, lines 20-25, for "monitor center" for handling a "problem" would have been obvious as mere different equivalent name for the same function.

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6. As for independent method claim 2, it's rejected for the same reason set forth in apparatus claim 1 above since they have similar limitations (a) – (c) above. Note that the term “means for” reads over “step of”.

7. **Claims 3-7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over MADON above.**

As for **independent apparatus claim 3**, MADON discloses means for compensating to a customer for the time that active facilities are used to reestablish the interrupted service (see col. 1, lines 55-57). MADON fails to teach the details (or criteria) of the compensation (or settlement) and the connection or relationship with an insurer. However, it's well known to an artisan in the art that compensation varies with the degree of or the extent of damage of the interrupted service and it's normally negotiable item between the provider and the customer. In other word, it appears that the details of the compensation are not critical to the claimed invention. Furthermore, the determining of compensation is considered as result effective variables/parameters and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions, i.e. high damage high compensation and low damage low compensation, and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

As for **dep. claims 4-7** which also deals with the compensation criteria or details, they are rejected for the same reason set forth in claim 3 above.

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As for **independent method claim 8**, it's rejected for the same reason set forth in independent claim 3 with the steps of recording the time (as shown in independent claim 1 above) being rejected for the same reason set forth in claim 1 above (see col. 1, lines 20-30, 43-57, Figs. 30, 31 and 32).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

NPL: Article "Southern Bell ... Customers" is cited to teach well known concept of compensation or refunding of service charge for service unavailable or interrupted. The recording is inherently included to allow proper refund of the time the service was not available.

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9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
June 23, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER